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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,455	05/25/2005	Bernard Resiak	Q87902	6474
23373 7590 09/17/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
FOGARTY, CAITLIN ANNE				
ART UNIT		PAPER NUMBER		
1793				
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09/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/536,455

**Applicant(s)**

RESIAK ET AL.

**Examiner**

CAITLIN FOGARTY

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. Claims 10 – 24 are new and are pending. Claims 1 – 9 have been cancelled.

### *Status of Previous Rejections*

2. The objection to the specification has been withdrawn in view of the amendment filed June 6, 2008.

The 35 U.S.C. 103(a) rejection of claims 1 – 9 as being unpatentable over Bangaru et al. (US 6,228,183 from IDS) is moot since claims 1 - 9 have been cancelled.

### *Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 10 – 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bangaru et al. (US 6,228,183) in view of Heitmann et al. (US 5,554,233).

With respect to instant claims 10, 14, and 24, col. 1 lines 9 – 16, col. 5 lines 13 – 25 and claims 1 and 2 of Bangaru disclose a steel with an overlapping or close composition as shown in Table 1 below.

Table 1

Element	Instant Claim 10,14,24 (weight %)	Bangaru et al. (weight %)	Overlapping Range (weight%)
C	≤ 0.15	0.03 – 0.10	0.03 – 0.10
Nb	0.04 – 0.10	0.01 – 0.10	0.04 – 0.10
B	0.001 – 0.005	0.0005 – 0.0020	0.001 – 0.002
Mo	0.15 – 0.35	0.2 – 0.5	0.2 – 0.35
Mn	1.3 – 2.0	1.6 – 2.1	1.6 – 2.0
Si	0.15 – 1.30	0 – 0.6	0.15 – 0.6
Al	0.01 – 0.08	0 – 0.06	0.01 – 0.06

N	$\leq 0.015$	0.001 – 0.006	0.001 – 0.006
Ti	$\geq 3.5 \times \%N$	0.005 – 0.03	Meets conditions of claim 1
Fe + impurities	Balance	Balance	Balance
Cu	---	0 – 1.0	0
Ni	---	0 – 1.0	0
V	---	0.01 – 0.10	---
Cr	---	0 – 1.0	0
Ca	---	0 – 0.006	0
REM	---	0 – 0.02	0
Mg	---	0 – 0.006	0

In addition, Bangaru teaches that the low-carbon steel alloy can be used to fabricate linepipe which is a mechanical component and therefore the alloy is ready-for-use. They also teach that the steel alloy has a tensile strength of at least about 900 MPa which satisfies the limitation of claims 10 and 14 of a tensile strength greater than 800 MPa. Bangaru also discloses that the steel alloy has a microstructure comprising about 50 vol% to less than 90 vol% fine-grained lower bainite, fine-grained lath martensite, or mixtures thereof which satisfies the limitation of claims 10 and 14 that the alloy has essentially bainitic structure.

Claims 10 and 14 are product by process claims and even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Therefore, the process limitations of claims 10 and 14 do not have patentable weight.

Bangaru differs from instant claims 10 and 14 because it does not teach that the steel product is a wire or rod. However in order to obtain the desired shape of a rod, it would have been obvious to one of ordinary skill in the art to use the steel composition of Bangaru in the method of Heitmann for making a rod (see col. 2 line 58-col. 3 line 42 of Heitmann).

Claims 11 and 15 are product by process claims. All of the additional limitations recited in claims 11 and 15 are process limitations and therefore do not have patentable weight as discussed above. See MPEP 2113.

Claims 12 and 16 further limit the composition of carbon in the steel to 0.06-0.10 wt%. This range still overlaps with the range of 0.03-0.10 wt% taught in Bangaru.

Claims 13 and 17 further limit the composition of molybdenum to  $\leq 0.30$  wt% and the composition of manganese to  $< 1.80$  wt%. Both of the recited composition limitations still overlap with the compositional ranges disclosed in Bangaru of Mo: 0.2 – 0.5 wt% and Mn :1.6 – 2.1 wt%.

Since the claimed compositional ranges of claims 10, 12 – 14, 16, 17, and 24 either overlap, are close, or are within the ranges disclosed by Bangaru, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed low-carbon steel alloy composition from the steel composition disclosed by Bangaru because Bangaru teaches the same utility (i.e. a mechanical component with an essentially bainitic structure) in the whole disclosed range.

5. Claims 18 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitmann et al. (US 5,554,233) in view of Bangaru et al. (US 6,228,183).

With respect to instant claim 18, col. 2 line 55-col. 3 line 42 and col. 7 lines 41 – 67 of Heitmann teach a process for manufacturing a ready-for-use low-carbon steel mechanical component with elevated characteristics exhibiting a tensile strength at break of at least about 827 MPa (see col. 8 lines 9-12) which is within the range recited in instant claim 18. The process comprises starting from a billet (long semi-finished product) and then hot rolling the billet in the austenitic range into a bar. Heitmann refers to the product as a bar, however the bar has a diameter and is therefore in a rod shape and satisfies the limitation of instant claim 18. Then the rod is cooled directly during its hot rolling at a cooling rate sufficient to provide it with an essentially bainitic structure. Finally, the rod is worked by cold plastic deformation into its final shape.

Heitmann differs from instant claim 18 because it does not teach a low-carbon steel component with an overlapping composition with that of the instant claim. However, col. 1 lines 9 – 16, col. 5 lines 13 – 25 and claims 1 and 2 of Bangaru disclose a low-carbon steel with an overlapping or close composition as shown in Table 2 below.

Table 2

Element	Instant Claim 18, 21 (weight %)	Bangaru et al. (weight %)	Overlapping Range (weight%)
C	≤ 0.15	0.03 – 0.10	0.03 – 0.10
Nb	0.04 – 0.10	0.01 – 0.10	0.04 – 0.10
B	0.001 – 0.005	0.0005 – 0.0020	0.001 – 0.002
Mo	0.15 – 0.35	0.2 – 0.5	0.2 – 0.35
Mn	1.3 – 2.0	1.6 – 2.1	1.6 – 2.0
Si	0.15 – 1.30	0 – 0.6	0.15 – 0.6
Al	0.01 – 0.08	0 – 0.06	0.01 – 0.06
N	≤ 0.015	0.001 – 0.006	0.001 – 0.006
Ti	≥ 3.5 x %N	0.005 – 0.03	Meets conditions of claim 18

Fe + impurities	Balance	Balance	Balance
Cu	---	0 – 1.0	0
Ni	---	0 – 1.0	0
V	---	0.01 – 0.10	---
Cr	---	0 – 1.0	0
Ca	---	0 – 0.006	0
REM	---	0 – 0.02	0
Mg	---	0 – 0.006	0

It would have been obvious to one of ordinary skill in the art to use the steel composition of Bangaru in the method of Heitmann in order to obtain a desired rod shape rather than a steel plate shape.

In regards to instant claim 19, col. 3 lines 10 – 16 of Heitmann disclose that the removal temperature of the rod after rolling is 780-855°C which is within the recited range of below 1000°C.

Regarding instant claim 20, col. 6 lines 52-62 of Heitmann teach that the cooling rate can be 4-8°C/s which is above the minimum of 1°C/s recited in instant claim 20.

Since the claimed compositional ranges of claim 18 either overlap, are close, or are within the ranges disclosed by Bangaru, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed low-carbon steel alloy composition from the steel composition disclosed by Bangaru because Bangaru teaches the same utility (i.e. a mechanical component with an essentially bainitic structure) in the whole disclosed range.

6. Claims 21 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitmann et al. (US 5,554,233) in view of the *ASM Handbook* and further in view of Bangaru et al. (US 6,228,183).

With respect to instant claim 21, col. 2 line 55-col. 3 line 42 and col. 7 lines 41 – 67 of Heitmann teach a process for manufacturing a ready-for-use low-carbon steel mechanical component with elevated characteristics exhibiting a tensile strength at break of at least about 827 MPa (see col. 8 lines 9-12) which is within the range recited in instant claim 21. The process comprises starting from a billet (long semi-finished product) and then hot rolling the billet in the austenitic range into a bar. Heitmann refers to the product as a bar, however the bar has a diameter and is therefore in a rod shape and satisfies the limitation of instant claim 21. Then the rod is cooled directly during its hot rolling at a cooling rate sufficient to provide it with an essentially bainitic structure. Finally, the rod is worked by cold plastic deformation into its final shape.

Heitmann differs from instant claim 21 because it does not teach the hot-rolled rod is subject to plastic transformation by forging at a temperature of about 1200°C or more to bring it to the final desired shape and then thermally treated by quenching at a cooling rate sufficient to provide it with a bainitic or essentially bainitic structure through to the core. However, the process step of subjecting a hot-rolled rod to forging at a temperature of a maximum of 1290°C to create a final desired shape is well known in the art as evidenced p. 81 and 218-221 of Volume 14 of the 1988 9<sup>th</sup> Edition *ASM Handbook*. The *ASM Handbook* also teaches the step of quenching in order to obtain the desired physical properties. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the method steps of the *ASM Handbook* in the method of Heitmann as an alternative method for creating a desired shape of a low-



carbon steel alloy with an essentially bainitic structure and a tensile strength at break of more than 800 MPa.

Heitmann also differs from instant claim 21 because it does not teach a low-carbon steel component with an overlapping composition with that of the instant claim. However, col. 1 lines 9 – 16, col. 5 lines 13 – 25 and claims 1 and 2 of Bangaru disclose a low-carbon steel with an overlapping or close composition as shown in Table 3 below.

Table 3

Element	Instant Claim 21 (weight %)	Bangaru et al. (weight %)	Overlapping Range (weight%)
C	≤ 0.15	0.03 – 0.10	0.03 – 0.10
Nb	0.04 – 0.10	0.01 – 0.10	0.04 – 0.10
B	0.001 – 0.005	0.0005 – 0.0020	0.001 – 0.002
Mo	0.15 – 0.35	0.2 – 0.5	0.2 – 0.35
Mn	1.3 – 2.0	1.6 – 2.1	1.6 – 2.0
Si	0.15 – 1.30	0 – 0.6	0.15 – 0.6
Al	0.01 – 0.08	0 – 0.06	0.01 – 0.06
N	≤ 0.015	0.001 – 0.006	0.001 – 0.006
Ti	≥ 3.5 x %N	0.005 – 0.03	Meets conditions of claim 21
Fe + impurities	Balance	Balance	Balance
Cu	---	0 – 1.0	0
Ni	---	0 – 1.0	0
V	---	0.01 – 0.10	---
Cr	---	0 – 1.0	0
Ca	---	0 – 0.006	0
REM	---	0 – 0.02	0
Mg	---	0 – 0.006	0

It would have been obvious to one of ordinary skill in the art to use the steel composition of Bangaru in the method of Heitmann in view of the *ASM Handbook* in order to obtain a desired rod shape rather than a steel plate shape.

In regards to instant claim 22, col. 3 lines 10 – 16 of Heitmann disclose that the removal temperature of the rod after rolling is 780-855°C which is within the recited range of below 1000°C.

Regarding instant claim 23, col. 6 lines 52-62 of Heitmann teach that the cooling rate can be 4-8°C/s which is above the minimum of 1°C/s recited in instant claim 23.

Since the claimed compositional ranges of claim 21 either overlap, are close, or are within the ranges disclosed by Bangaru, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed low-carbon steel alloy composition from the steel composition disclosed by Bangaru because Bangaru teaches the same utility (i.e. a mechanical component with an essentially bainitic structure) in the whole disclosed range.

### ***Response to Arguments***

7. Applicant's arguments filed June 6, 2008 have been fully considered but they are not persuasive.

Arguments are summarized as follows:

- a. The amounts of alloying elements disclosed in Bangaru are by weight percent, whereas in the present claims, the percentages are given by weight, but with respect to the iron content. Thus, the chemical composition of the steel of Bangaru is different from that of the present invention.
- b. Bangaru is concerned with "flat-products" whereas the present invention relates to "long products."
- c. The manufacture of the slabs of Bangaru involves hot rolling, and there is no (cold or hot) forging step involved in the manufacture as in the instant invention.

- d. It is not obvious from Bangaru that the steel composition recited in claim 10, 14, 18, 21 and 24 is particularly adapted for forging, either by cold or hot processes, mechanical components with elevated characteristics.
- e. Bangaru does not disclose or suggest the processes of claims 18 and 21, which permits the manufacture of read-to-use forged mechanical components with elevated characteristics without additional heat treatment after forging.
- Examiner's responses are as follows:

- a. In absence of comparison data for the instant low-carbon steel composition and the steel composition of Bangaru, the Examiner maintains the position that the composition of the steel of Bangaru is overlapping or close with that of the instant invention.
- b. See new 35 U.S.C. 103(a) rejection above containing a secondary reference.
- c. – e. See new 35 U.S.C. 103(a) rejection above with a new primary reference.

***Conclusion***

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/

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